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EXAMINER

GEHMAN, BRYON P

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/715,180
Filing Date: November 17, 2003
Appellant(s): WEINGARDEN, MARSHALL L.

Arthur Jacob
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed September 27, 2005 appealing from the Office action mailed November 4, 2004.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

There are no related appeals or interferences.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,574,188	FLIEGEL	6-2003
5,332,089	TILLET ET AL	7-1994
5,975,291	ATTAR ET AL	11-1999
5,417,324	JOYCE ET AL	5-1995
5,735,396	CONDORODIS	4-1998
6,276,524	CERDA-VILAPLANA ET AL	8-2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 5, 7-10, 13-14, 16, 18 and 20 were rejected under 35 U.S.C. 102(b) as being anticipated by Tillett et al. (5,332,089). Claims 1-3, 5, 7-10, 13-14, 16, 18 and 20 were rejected under 35 U.S.C. 102(e) as being anticipated by Fliegel (Figures 3-5)(6,574,188). Each discloses a hub post (20; 1; respectively) comprising a base having a basal surface (undersurface of 20; undersurface at 14 or 13 alone), the base having a lateral (radial) extent, a layer of adhesive on the basal surface (adhesive at 24, see column 4, lines 25-40; 13), a post (axial portion of 20; axial portion of 12 or 19) projecting (axially) from the base and including a substantially continuous, unbroken axial gripping surface, the base and post being integral and substantially solid and constructed from stiffly resilient synthetic polymeric material (cross-linked, closed-cell polyolefin foam; moss rubber) having resilient characteristics.

As to claims 2-3 and 13-14, the base and post are unitary and solid in construction.

As to claims 5 and 16, the durometer may be inherently met.

As to claim 7-10, the basal surface is spaced from the gripping surface and the further limitations relative to area and a base flange are met.

As to claims 18 and 20, the post is generally cylindrical.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 7-10, 13-16, 18 and 20 were rejected under 35 U.S.C. 103(a) as being unpatentable over either one of Tillett et al. and Fliegel in view of Attar et al. (5,975,291). Tillett et al. and Fliegel have been explained above. To any degree it may be shown that the hub posts of Tillett et al. and Fliegel do not meet all the functional recitation of the claims, Attar et al. disclose a hub post constructed from (poly)urethane (see column 3, lines 18-57). To substitute the hub post material of Attar et al. for the hub post material of either one of Tillett et al. and Fliegel would have been obvious in order to allow some flexing but work well for a CD hub post, as suggested by Attar et al..

As to claims 2-3 and 13-14, the base and post of each of Tillett et al. and Fliegel are unitary and solid in construction.

As to claims 5 and 16, the durometer should be inherently met by the (poly)urethane of Attar et al..

As to claim 7-10, the basal surface of each of Tillett et al. and Fliegel is spaced from the gripping surface and the further limitations relative to area and a base flange are met.

As to claims 18 and 20, the post of each of Tillett et al. and Fliegel is generally cylindrical.

Claims 6 and 17 were rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claims 1 and 9 above, and further in view of Joyce et al. (5,417,324). Joyce et al. disclose providing a hub post of transparent polystyrene. To modify the employed prior art further by employing transparent (poly)urethane would have been obvious in view of Joyce et al. in order to allow viewing of the disk of the hub post without visual obstruction by the hub post.

Claims 11 and 12 were rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 9 above, and further in view of Condorodis (5,735,396). Condorodis discloses a canted hub post (see Figures 5 and 6A). To modify the employed prior art further by canting the hub post in the manner suggested by Condorodis would have been obvious in order to facilitate application of a disk to the hub post, as suggested by Condorodis.

Claims 19 and 21 were rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claims 9 and 1 above, and further in view of Cerda-Vilaplana et al. (6,276,524). Cerda-Vilaplana et al. discloses a polyhedral hub post. To modify the employed prior art further by employing a polyhedral shape for the hub post would have been obvious, as such a shape was well known in the hub post field.

(10) Response to Argument

With respect to Tillett et al., at column 4, lines 14-24 of that reference, the hub post of that reference is described as made of a “resiliently compressible material... a cross-linked closed-cell polyolefin foam providing the desired easily but resiliently compressible nature”. In use, this hub post would provide selective gripping and selective release and would resist deleterious compression and crushing while retaining a disk on the hub post in common and intended usage. The inherent durometer of the material of the hub post of Tillett et al., by being disclosed by Tillett et al. to grip and retain a disk thereon, would provide “a balance of resilient characteristics and resilient characteristics for establishing... selective gripping and selective release and.... resisting deleterious compression and crushing” as much as claimed by the appellant.

With respect to Fliegel, at column 4, lines 42-60 of that reference, the hub post of that reference is described as made of a “yielding material, which advantageously is a so-called moss rubber”. In use, this hub post would provide selective gripping and selective release and would resist deleterious compression and crushing while retaining

a disk on the hub post in common and intended usage. The inherent durometer of the material of the hub post of Fliegel, by being disclosed by Fliegel to grip and retain a disk thereon, would provide "a balance of resilient characteristics and resilient characteristics for establishing... selective gripping and selective release and.... resisting deleterious compression and crushing" as much as claimed by the appellant.

Appellant argues that the examiner makes assumptions about the structure of the prior art to Tillett et al. and Fliegel as to properties not expressly disclosed in the specification. However, conversely in arguing about the limitations of the prior art as to functionality, appellant makes negative assumptions about the prior art with respect to its capabilities without there being any factual evidence provided by the reference or by appellant that the hub post does not possess the inherent capabilities. Appellant argues the prior art hub posts do not retain a disk in the manner claimed, which is an assumption on appellant's part without any evidential basis, and contrary to the express disclosure of the prior art hub posts of Tillett et al. and Fliegel and the disclosure by the prior art that the hub posts are each designed to retain a disk thereon as disclosed. The degree of "resilient characteristics and resilient characteristics for establishing... selective gripping and selective release and for resisting deleterious compression and crushing while retaining the disk upon the post" is met by Tillett et al. and Fliegel inasmuch as they are set forth in the claims as rejected in view of only those two references.

Appellant argues that the prior art does not describe a durometer of the hub post material. However, resilient structures all possess a durometer (a relative hardness of the material). The durometer of a resilient material is measured on the Shore "A" scale

in a range between 0 and 100, lower numerical values being softer and more resilient and higher numerical values being harder and less resilient. Accordingly, the prior art resilient hub posts of Tillett et al. and Fliegel both possess an inherent durometer value. To argue that these prior art hub posts fail to possess a durometer because one is not disclosed therefore is similar to saying they lack a volume or a mass because these physical characteristics are not expressly disclosed.

With respect to claims 5 and 16, these claims were rejected under section 102 because the inherent durometer of the prior art hub posts to Tillett et al. and Fliegel could not be ascertained from the references. To any degree it can be shown that the encompassed durometer of the hub post materials of Tillett et al. and Fliegel do not anticipate the claimed range of durometer, the 103 rejection incorporating Attar et al. has been made, to indicate that hub posts have been previously provided from a material (polyurethane, appellant's disclosed material to provide the claimed durometer) having an inherent durometer to sufficiently secure a disk to a hub post.

With respect to claims 6 and 17, the teaching of Joyce et al. was employed to provide the basis of providing a hub post that is transparent was not new in the field of disk hub posts in containers. While the Joyce et al. material is disclosed as brittle, it is not the material being employed, but the concept of using transparent polymeric materials to comprise a hub post that has been employed by the examiner in the rejection, and transparent polyurethane would work equally as well as any other transparent material in the manner suggested by Joyce et al.. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the

structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

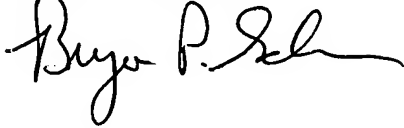
With respect to claims 11 and 12, Condorodis discloses a hub post (26) with a surface canted at an angle to facilitate application of a disk to the hub post (see column 2, lines 3-18). The portion of the hub post being canted is not expressed in the claim to distinguish over the canted surface of Condorodis.

With respect to claims 19 and 21, Cerda-Vilaplana et al. disclose a hub post having a polyhedral shape. While not directed to a resilient hub post per se, the reference does disclose it was known in the field of disk hub posts to provide such a hub post in a polyhedral shape. A hub post shape teaching is not seen as being non-analogous based on the compositional material or additional structure not precluded by the claims. It has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Cerda-Vilaplana et al. disclose it known to provide a polyhedral shape for a hub post, its composition of a particular material not precluding its employment.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Bryon P. Gehman

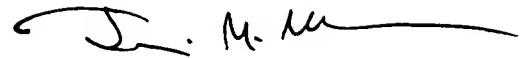
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Conferees:

Mickey Yu

A handwritten signature in black ink, appearing to read "Mickey Yu", with a stylized, flowing script.

Jila Mohandesi

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